NOMURA et al.
Appl. No. 09/892,512
Response to Office Action dated December 2, 2004

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 1-4, 7-12 and 15-19 were rejected under 35 U.S.C. Section 102(b) as allegedly being "anticipated" by Wadsworth *et al.* (U.S. Patent No. 5,657,448). While not acquiescing in this rejection, claims 1-4, 7, 9 and 15 have been amended and claims 18 and 19 have been canceled without prejudice or disclaimer. As such, the discussion below makes reference to the amended claims.

Each of the independent claims 1 and 9 involves a server determining whether a program is operable in an operating environment of a user terminal based on operating environment information received from the user terminal, and transmitting a result of this determination as to operability to the user terminal. Wadsworth *et al.* at least fails to disclose these features.

Wadsworth *et al.* relates to a circuit board (referenced in Wadsworth *et al.* as a "NEB") which is coupled to a local area network peripheral such as a printer and which allows the peripheral to be "an intelligent, interactive network member eliminating the necessity of dedicating a personal computer to manage the peripheral." Wadsworth *et al.*, col. 1, lines 11-15. As described beginning at col. 48, line 15 of Wadsworth *et al.*, a NEB is configured initially prior to shipping. However, the NEB can be reconfigured subsequently by sending updated executed files across the LAN from a network administrator's PC to the NEB. The network administrator can also remotely alter the executable files stored in the memory of the NEB. With specific reference to Wadsworth *et al.* Figure 20, a DOWNLOADER program broadcasts over the LAN a request for identification of all NEB devices having a particular configuration. (Step 2001). If a target NEB responds at Step 2002, the network administrator selects a particular NEB to download an executable file, and new operational files and a checksum value are downloaded to the memory of the NEB over the LAN.

While the DOWNLOADER program requests an identification of all NEB devices having a particular configuration, there is no description in Figure 20 or the accompanying text of the NEB devices sending configuration information in response to this identification request. Even assuming that the administrator's PC were argued to receive such configuration information

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(*see, e.g.,* col. 15, lines 18-25), there is no disclosure of the administrator's PC using such received information to determine whether a program is operable in the environment of the NEB. In addition, there is absolutely no disclosure of transmitting a result of such a determination back to the NEB. Indeed, in the context of the DOWNLOADER program, there would appear to be no reason to communicate such information to the NEB. Because of these deficiencies of Wadsworth *et al.* with respect to claims 1 and 9 (including, by way of example, the failure to transmit a result of a determination as to program operability from a server to a user terminal), Wadsworth *et al.* cannot anticipate these claims or the claims that depend therefrom. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

The office action references col. 34, line 15 to col. 35, line 30 and col. 38, line 10 to col. 40, line 42 of Wadsworth *et al.* in connection with the features of claim 1.

The first referenced portion of Wadsworth *et al.* relates to the CPCONSOL utility executed from the system administrator's PC. CPCONSOL gives the system administrator access to statistics about the printer operation as well as the efficiency of network communications. The functions of CPCONSOL are described as being divided into five groups: Environment, Network, Logging, Application Control, and Printer Status. While the Environment function allows CPCONSOL to display the current environment of a selected printer, there is no disclosure or suggestion that this function is operable to, for example, transmit a result of a determination as to program operability from a server to a user terminal as specified in claims 1 and 9.

The second referenced portion of Wadsworth *et al.* relates to the Application Control and printer status functions of the CPCONSOL utility and to the NEB responses to a status inquiry using CPSOCKET.

Wadsworth *et al.* describes that the Application Control function allows CPCONSOL to "view the current configuration of the NEB within the network ..." Wadsworth *et al.*, col. 38, lines 11-12. The Printer Status function allows CPCONSOL to display the current status of the printer attached to the NEB. There is no description that either of these functions involves

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transmitting a result of a determination as to program operability from a server to a user terminal as specified in claims 1 and 9.

The CPSOCKET application program is responsible for the internal configuration of the NEB, as well as maintaining a table of default settings for the device environment, downloading basic configuration information for the printer at device power-up, providing device status information, statistics and log information in response to CPCONSOL requests, and providing reset , re-boot and firmware download capabilities. CPSOCKET runs on the NEB (*see, e.g.,* col. 38, lines 66-67). Thus, this program does not, for example, transmit a result of a determination as to program operability from a server to a user terminal as specified in claims 1 and 9. In addition, there is no description of this application program receiving such a determination result.

Claims 1 and 9 make reference to optional units that are combined with a terminal main body. Among other things, Applicants do not find a discussion in Wadsworth *et al.* of optional units, of determining an operating environment based on optional units or transmitting operation environment information to a server. For these additional and independent reasons, claims 1 and 9 are not anticipated by Wadsworth *et al.*

In connection with the displaying of claim 2, the office action references col. 38, line 10 to col. 39, line 20 of Wadsworth *et al.* However, this portion of Wadsworth *et al.* only mentions displaying printer status information on the system administrator's PC and does not disclose or suggest any display at the user terminal, much less the display of a program operability determination result. For these additional and independent reasons, claim 2 is not anticipated by Wadsworth *et al.*

The office action references this same portion of Wadsworth *et al.* in connection with claims 3 and 4. However, there is no description in this portion of Wadsworth *et al.* of transmitting an order for a program from a user terminal to a server. Indeed, Wadsworth *et al.* specifically notes that it is the network administrator that remotely alters the executable files of the NEB. *See* Wadsworth *et al.*, col. 48, lines 24-26. There is no disclosure of the NEB transmitting an order for a program. For these additional and independent reasons, claims 3 and 4 are not anticipated by Wadsworth *et al.*

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In connection with the result recording of claim 7, the office action references col. 33, lines 40-57 of Wadsworth *et al.* While this portion of Wadsworth *et al.* describes the logging of various information, there is no discussion of a program operability determination result or the storing of such a result. For these additional and independent reasons, claim 7 is not anticipated by Wadsworth *et al.*

Claims 5, 6, 13 and 14 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Wadsworth *et al.* in view of Rose (U.S. Patent No. 5,708,709). Rose is cited in connection in the program list recited in dependent claims 5, 6, 13 and 14. However, Rose does not remedy the deficiencies of Wadsworth *et al.* in connection with claims 1 and 9, from which claims 5, 6, 13 and 14 depend. As such, the subject matter of these claims would not result even if these documents were forcedly combined as proposed in the office action. In addition, Rose does not disclose a program list indicative of programs operable in an operating environment of a user terminal based on operating environment information transmitted to a server. This feature even further distinguishes claims 6 and 14 from the proposed combination of Wadsworth *et al.* and Rose.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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